

MAY 29 2008

Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Silver**Group Art Unit:** 2614**Application No.:** 10/673,949**Examiner:** Ramakrishnaiah**Filed:** September 29, 2003**Title:** "SECOND COMMUNICATION DURING RING SUPPRESSION"

APPELLANT'S BRIEF IN SUPPORT OF APPEAL

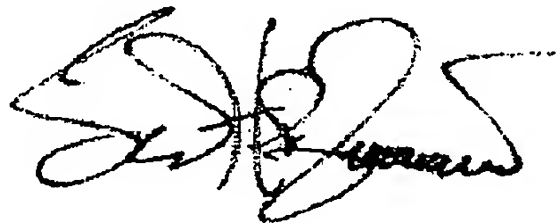
Mail Stop: Appeal Brief — Patents
Commissioner for Patents

The Assignee/Appellant hereby submits a Brief in Support of Appeal for the above-identified application. This Brief is accompanied by a credit card authorization form to charge the 37 C.F.R. § 41.20 (b) (2) large entity fee of \$510.00.

A Notice of Appeal was filed January 11, 2008. This Notice of Appeal was also accompanied by a Pre-Appeal Brief Request for Review. A panel decision was then mailed March 5, 2008.

If any questions arise, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,



Scott P. Zimmerman

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Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

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Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

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In re application of: Silver

Group Art Unit: 2614

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REAL PARTY IN INTEREST

BellSouth Intellectual Property Corporation (now doing business as AT&T Delaware Intellectual Property, Inc.), as the assignee of U.S. Patent Application 10/740,744, is the real party in interest.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences pertaining to the above-identified application.

STATUS OF CLAIMS

Claims 1-9 and 13-18 are pending in this application. Claims 10-12 were previously canceled without prejudice or disclaimer.

The Office finally rejected claims 1, 3-5, 7-9, 13, and 15-18 under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,714,637 to Kredo in view of U.S. Patent 4,893,329 to O'Brien.

Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

Claim 2 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Kredo* in view of *O'Brien* and further in view of U.S. Patent 6,700,957 to Horne. Claim 14 was rejected on this same basis.

Claim 6 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Kredo* in view of *O'Brien* and further in view of U.S. Patent 6,968,216 to Chen, *et al.*

The Appellant appeals these final rejections of claims 1-9 and 13-18.

STATUS OF AMENDMENTS

No amendments have been submitted subsequent to the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter generally relates to notification of an incoming communication during "ring suppression." Typically, when a customer receives a first incoming call, an initial audible alert (e.g., a ring) is produced. Afterwards, subsequent rings may be suppressed, such that additional rings are silenced. That is, the customer may always be provided an initial audible alert of the incoming call, but additional rings may be "suppressed" or silenced for some configurable period of time. Should the customer receive a second incoming call during ring suppression, the customer is still provided an alert of the second incoming call, even though the subsequent alerts of the first incoming call are suppressed.

A) Claim 1

In accordance with an exemplary embodiment, independent claim 1 recites a system, comprising:

Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

means for receiving a first incoming communication;
means for producing a first initial alert of the first incoming communication;
means for suppressing subsequent alerts of the first incoming communication for a period of time;
means for receiving a second incoming communication during the period of time of suppression; and
means for producing a second initial alert of the second incoming communication while the subsequent alerts of the first incoming communication are suppressed.

Textual support for claim 1 is also provided. The first incoming communication is discussed at least at paragraphs [0010], [0019], and [0021]. The first initial alert is discussed at least at [0010] and [0021]. Suppression of the subsequent alerts is discussed at least at [0010] and [0021]. The second incoming communication is discussed at least at [0010] and [0021]. The second initial alert is discussed at [0010], [0019], and [0021].

B) Claim 9

In accordance with another exemplary embodiment, claim 9 recites another system, comprising:

means for receiving a first incoming communication;
means for producing a first initial alert of the first incoming communication;
means for suppressing subsequent alerts of the first incoming communication for a period of time;
means for receiving a second incoming communication during the period of time of suppression; and
means for producing a second initial alert of the second incoming communication while the subsequent alerts of the first incoming communication are suppressed.

Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

Textual support for claim 9 is provided. The first incoming communication is discussed at least at paragraphs [0010], [0019], and [0021]. The first initial alert is discussed at least at [0010] and [0021]. Suppression of the subsequent alerts is discussed at least at [0010] and [0021]. The second incoming communication is discussed at least at [0010] and [0021]. The second initial alert is discussed at [0010], [0019], and [0021].

C) Claim 13

In accordance with yet another exemplary embodiment, claim 13 recites a method, comprising:

- receiving a first incoming communication;
- producing a first initial alert of the first incoming communication;
- suppressing subsequent alerts of the first incoming communication for a period of time;
- receiving a second incoming communication during the period of time of suppression; and
- producing a second initial alert of the second incoming communication while the subsequent alerts of the first incoming communication are suppressed.

Textual support for claim 13 is provided. The first incoming communication is discussed at least at paragraphs [0010], [0019], and [0021]. The first initial alert is discussed at least at [0010] and [0021]. Suppression of the subsequent alerts is discussed at least at [0010] and [0021]. The second incoming communication is discussed at least at [0010] and [0021]. The second initial alert is discussed at [0010], [0019], and [0021].

D) Claim 18

Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

In accordance with yet another exemplary embodiment, claim 18 recites a computer program product storing computer-readable instructions for performing a method for timed ring suppression, the method comprising:

- receiving a first incoming communication;
- producing a first initial alert of the first incoming communication;
- suppressing subsequent alerts of the first incoming communication for a period of time;
- receiving a second incoming communication during the period of time of suppression; and
- producing a second initial alert of the second incoming communication while the subsequent alerts of the first incoming communication are suppressed.

Textual support for claim 18 is provided. The first incoming communication is discussed at least at paragraphs [0010], [0019], and [0021]. The first initial alert is discussed at least at [0010] and [0021]. Suppression of the subsequent alerts is discussed at least at [0010] and [0021]. The second incoming communication is discussed at least at [0010] and [0021]. The second initial alert is discussed at [0010], [0019], and [0021].

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The Appellant appeals the final rejection of claims 1-9 and 13-18 as being obvious over various combinations involving U.S. Patent 6,714,637 to Kredo in view of U.S. Patent 4,893,329 to O'Brien.

ARGUMENT

1. Due Process Requires an Adequate Response

Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

The Office has not provided Due Process. The Appellant has twice presented compelling evidence that any combination involving *Kredo* and *O'Brien* "teaches away" by requiring "impermissible changes." More specifically, the Appellant has argued that either *Kredo* or *O'Brien* must have its principle of operation impermissibly changed to support the *prima facie* case for obviousness. M.P.E.P. § 2143.01 explains that when a proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. The Examiner, however, completely failed to respond to this "impermissible changes" standard. When the Examiner issued an Advisory Action, the Examiner wrote that "it would have been obvious to one of ordinary skill in the art" to modify *Kredo* with the teachings of *O'Brien*. The Examiner also wrote "it is clear that the applicant is arguing against individual references."

The Advisory Action, then, demonstrates a lack of understanding of the "impermissible changes" standard. When an Applicant argues "impermissible changes" are required, the Office cannot respond with obviousness. Regardless of what a document teaches, if a principle of operation must be changed, then the document cannot support a *prima facie* case. The Advisory Action fails to address why, or why not, *Kredo's* or *O'Brien's* principle of operation must be changed to support the Office's *prima facie* case for obviousness. The Advisory Action is thus not responsive to the Appellant's "impermissible changes" position. Even the Panel's Decision seems to misunderstand the "impermissible changes" standard.

The Office, then, has not provided Due Process. The Assignee has twice argued that *Kredo* with *O'Brien* "teaches away" by requiring an impermissible change to their respective principles of operation. The Office, however, has failed to respond to this argument. The Office merely responded by reiterating how the pending claims are allegedly obvious. The Office did not respond to, nor does the Office seem to understand, the "impermissible changes" standard. Due Process, then, requires that the Office consider these "impermissible changes" and provide a response supported by evidence. Any other action is a violation of the Assignee's Due Process safeguards.

Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

The Board is thus respectfully requested to remove the final rejection of the pending claims. The Appellant also respectfully requests that the Board either i) allow the claims or ii) remand the application back to the Examiner for an adequate response to the Appellant's "impermissible changes" argument.

2. The Office Has Failed to Carry the Burden

The Office has failed to carry its burden of responding to the Appellant's "impermissible changes" argument. When the Appellant presented compelling evidence that "impermissible changes" would be required to make the *prima facie* cases, the Office had the burden of rebuttal. The Office, instead, responded with an incorrect obviousness rejection.

The Office has failed its burden. The Appellant has argued that *Kredo* with *O'Brien* cannot support a *prima facie* case for obviousness. The Appellant, in particular, has presented compelling evidence that either *Kredo* or *O'Brien* must have its principle of operation impermissibly changed to support the *prima facie* case for obviousness. The burden then shifted to the Office for acquiescence or for a factual rebuttal. The Office, instead, responded with silence. The Office has thus failed its burden.

The Board is thus respectfully requested to remove the final rejection of the pending claims. The Appellant also respectfully requests that the Board either i) allow the claims or ii) remand the application back to the Examiner for an adequate response to the Appellant's "impermissible changes" argument.

3. *Kredo* with *O'Brien* "Teaches Away" by Requiring "Impermissible Changes"

The Office finally rejected the pending claims under § 103 (a) as allegedly being obvious over various combinations of *Kredo* and *O'Brien* with *Horne* and/or *Chen*.

Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

Any combination involving *Kredo* with *O'Brien*, however, "teaches away" by requiring "impermissible changes." "A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See M.P.E.P. at § 2143.01.

The Examiner's *prima facie* cases all require impermissible changes to either *Kredo's* or *O'Brien's* principles of operation. Examiner Ramakrishnaiah proposes to combine *Kredo's* customized call waiting indicators with *O'Brien's* device for deferring incoming calls. This proposed combination, however, requires impermissible changes to *Kredo's* or *O'Brien's* principles of operation. When *O'Brien* defers an incoming call, *O'Brien* "seizes the telephone line" and the incoming call "will not be completed" to the called party. That is, *O'Brien's* device for deferring incoming calls would not allow for *Kredo's* customized call waiting indicators. The proposed combination of *Kredo* with *O'Brien*, then, would never permit "receiving a first incoming communication" and "producing a first initial alert of the first incoming communication," as the independent claims recite. The proposed combination of *Kredo* with *O'Brien* would also never permit "receiving a second incoming communication during the period of time of suppression" and "producing a second initial alert of the second incoming communication," as the independent claims recite. As *Kredo's* or *O'Brien's* principle of operation must be impermissibly changed, the *prima facie* cases for obviousness must fail.

Kredo and *O'Brien* explain their principles of operation. *Kredo* discloses customized call waiting indicators, such as custom audio files, tones, and text that are associated to calling phone numbers. See U.S. Patent 6,714,637 to *Kredo* at column 2, lines 35-45. See also *id.* at column 2, lines 60-65 and at column 4, lines 1-10. *O'Brien* describes a device that defers incoming

Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

telephone calls so as not to disturb the called party. See U.S. Patent 4,893,329 to O'Brien at column 1, lines 6-13. "In the defer mode of operation, the device detects a valid ring signal, suppresses the telephone ringers, seizes the telephone line and transmits to the calling party a ... voice message." *Id.* at column 2, lines 6-10 (emphasis added). "While the subscriber line is in the defer mode, calls placed to it will not be completed but will instead be intercepted at the central office." *Id.* at column 10, lines 41-43 (emphasis added). "The calling party will be given a voice message ... that the called party is not accepting calls." *Id.* at column 10, lines 44-46 (emphasis added). Local and long distance calls are not completed when in the defer mode of operation. See *id.* at column 10, lines 55-58.

Kredo with *O'Brien*, then, "teaches away" from the pending claims. If *Kredo* is combined with *O'Brien*, as the Office proposes, then *Kredo*'s entire teaching (e.g., customized call waiting indicators) must be eliminated, or, *O'Brien*'s principle of operation must be changed to not play a voice message and to, instead, allow incomings calls to be completed. Because the patent laws forbid changing a principle of operation to support a *prima facie* case, the proposed combination of *Kredo* with *O'Brien* cannot support a *prima facie* case for obviousness. All the *prima facie* cases for obviousness must fail, so the Office is respectfully requested to remove the § 103 (a) rejections of the pending claims.

The Board of Patent Appeals and Interferences is thus respectfully requested remove the final rejection of the pending claims. The Appellant also respectfully requests that the Board either i) allow the claims or ii) remand the application back to the Examiner for an adequate response to the Appellant's "impermissible changes" argument.

CONCLUSION

In view of the foregoing reasons, the Appellant respectfully requests removal of the § 103 (a) rejections of claims 1-9 and 13-18.

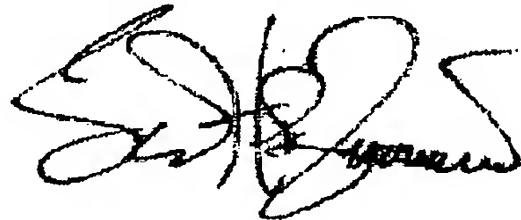
AUTHORIZATION FOR PAYMENT OF FEES

Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

If there are any other fees due in connection with the filing of this brief in support of appeal, please charge the fees to the credit card identified in the Credit Card Payment Form submitted herewith. If any additional fees are required, such as a fee for an extension of time under 37 C.F.R. § 1.136, such extension of time is requested and the fee should also be charged to the credit card on file.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,



Scott P. Zimmerman
Attorney for the Assignee/Appellant
Reg. No. 41,390

Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

CLAIMS APPENDIX

U.S. Patent Application No. 10/673,949 Pending Claims

[c01] A system, comprising:

- means for receiving a first incoming communication;
- means for producing a first initial alert of the first incoming communication;
- means for suppressing subsequent alerts of the first incoming communication for a period of time;
- means for receiving a second incoming communication during the period of time of suppression; and
- means for producing a second initial alert of the second incoming communication while the subsequent alerts of the first incoming communication are suppressed.

[c02] The system of claim 1, further comprising means for associating the first incoming communication to a profile.

[c03] The system of claim 1, further comprising means for retrieving a timing parameter that specifies the period of time of suppression.

[c04] The system of claim 1, further comprising means for enabling alerts after the time period has passed.

[c05] The system of claim 3, wherein the timing parameter ranges from approximately one second to approximately two minutes.

[c06] The system of claim 1, further comprising means for retrieving a schedule preference that enables timed ring suppression for times of day and days of week.

Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

[c07] The system of claim 1, further comprising means for receiving an incoming call as the first incoming communication, means for producing a first ring and means for suppressing subsequent rings for a period of time.

[c08] The system of claim 7, further comprising means for receiving a second incoming call as the second incoming communication, means for producing another ring to alert of the second incoming call during the period of time in which the subsequent rings are suppressed.

[c09] A system, comprising:

- means for processing a first incoming communication;
- means for sending a first initial alert of the first incoming communication;
- means for suppressing subsequent alerts of the first incoming communication for a period of time;
- means for processing a second incoming communication during the period of time of suppression; and
- means for sending a second initial alert of the second incoming communication while the subsequent alerts of the first incoming communication are suppressed.

[c10] (Cancel)

[c11] (Cancel)

[c12] (Cancel)

[c13] A method, comprising:

- receiving a first incoming communication;
- producing a first initial alert of the first incoming communication;

Attorney Docket: 030552
U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Appellant's Brief in Support of Appeal

suppressing subsequent alerts of the first incoming communication for a period of time;

receiving a second incoming communication during the period of time of suppression; and

producing a second initial alert of the second incoming communication while the subsequent alerts of the first incoming communication are suppressed.

[c14] The method of claim 13, further comprising associating the first incoming communication to a profile.

[c15] The method of claim 13, further comprising retrieving a timing parameter that specifies the period of time of suppression.

[c16] The method of claim 13, further comprising enabling alerts after the time period has passed.

[c17] The method of claim 15, wherein the timing parameter is greater than two minutes.

[c18] A computer program product storing computer-readable instructions for performing a method for timed ring suppression, the method comprising:

receiving a first incoming communication;

producing a first initial alert of the first incoming communication;

suppressing subsequent alerts of the first incoming communication for a period of time;

receiving a second incoming communication during the period of time of suppression; and

producing a second initial alert of the second incoming communication while the subsequent alerts of the first incoming communication are suppressed.

U.S. Application No. 10/673,949 Examiner Ramakrishnaiah Art Unit 2614
Attorney Docket: 030552
Appellant's Brief in Support of Appeal

EVIDENCE APPENDIX

There are no submissions pursuant to 37 CFR § 41.37 (c) (ix) for U.S. Patent Application No. 10/673,949.

RELATED PROCEEDINGS APPENDIX

There are no submissions pursuant to 37 CFR § 41.37 (c) (x) for U.S. Patent Application No. 10/673,949.